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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/016,277   | 11/02/2001  | Peter Hsiuen Wu      | 38190/201827        | 3510             |
| 826  | 7590        | 01/11/2005           | EXAMINER            |                  |
| ALSTON & BIRD LLP<br>BANK OF AMERICA PLAZA<br>101 SOUTH TRYON STREET, SUITE 4000<br>CHARLOTTE, NC 28280-4000 |             |                      | ART UNIT            | PAPER NUMBER     |

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|--|------------------------|---------------------|
| <b>Notification of Non-Compliant Appeal Brief<br/>(37 CFR 41.37)</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|  | 10/016,277             | WU, PETER HSIUEN    |
| <b>Examiner</b>  | <b>Art Unit</b>        |                     |
| John Ruggles   | 1756                   |                     |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 21 December 2004 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file a complete new brief in compliance with 37 CFR 41.37 within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1.  The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2.  The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3.  At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4.  (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5.  The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi))
6.  The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7.  The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8.  The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9.  The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10.  Other (including any explanation in support of the above items):

Item 2: Section 3 of the appeal brief must identify the status of ALL claims, including those under appeal (claims 1-49 have been finally rejected) as well as those that have been cancelled during prosecution (claims 50-63 have been cancelled).

Item 4: Section 5 of the appeal brief includes a statement of purpose (which is unnecessary in this section) for the instant invention and a partial summary (which is required for each and every independent claim under appeal) for independent claim 1 by description of [1] applying a maskant coating to a metal substrate, but Appellant has failed to specify that claim 1 also includes [2] exposing the coated substrate to actinic radiation to cure the maskant coating and [3] subjecting the coated substrate to chemical treatment; [4] Section 5 also fails to summarize the recited features of ALL independent claims by excluding any mention of independent claims 19 and 48, which are also under appeal; [5] Appellant further fails to connect the recited features to the drawings by reference numbers (e.g., see Figure 2 filed on 17 December 2003, etc.).

Item 6: Section 7 states that each separate argument applies equally to each rejection of record, but does not present separate arguments, each under a separate heading, for EACH and every separate ground of rejection on appeal (even though Appellant acknowledges in Section 6 of the brief that 5 separate final rejections remain for consideration on appeal). This is taken to mean that all 5 separate rejections applying to claims 1-49 are being argued together (and stand or fall together), so that only a single claim from the entire group of appealed claims 1-49 needs to be considered for appeal.

*J. Ruggles*

Application No. 10/016,277

John Ruggles  
Examiner, Art Unit 1756  
571-272-1390

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)

Part of Paper No. 20050103

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